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APPLICANT: Robert N. Falco)
SERIAL NUMBER: 09/226,467) Group Art Unit
FILED: January 1, 1999) 2837
FOR: DETECTABLE EARPLUG AND METHOD) Examiner:
OF MANUFACTURE THEREOF) K. Dang

REPLY BRIEF

(1) REAL PARTY IN INTEREST

The real party in interest is Cabot Safety Intermediate Corporation.

(2) STATUS OF CLAIMS

The Examiner has indicated that claims 14 and 15 are allowable. With regard to claims 1-13 and 16-23, the previous statement of the status of the claims is maintained.

(3) STATUS OF AMENDMENTS

The previous statement of the status of amendments is maintained.

(4) SUMMARY OF INVENTION

For the convenience of the Examiner and the Board, the previously stated summary is reproduced:

Disclosed is a unique earplug 10 including a foam body 14 having a detectable insert 12 completely encased by the foam body 14. The earplug 10 is manufactured by forming a channel 30 in the foam body 14 and placing the detectable insert 12 into the channel 30. The channel 30 is formed by deforming the foam body 14 using a punch 20. The foam body 14 is made from a slow recovery foam which returns to its original shape, and thereby encapsulating the detectable insert 12 within the foam body 14. In an alternative embodiment, the insert 12 is projected into the foam body 14 and the foam body 14 recovers to encapsulate the insert 12. (See FIGS. 1-5, generally; see the specification at page 1, lines 11-17).

Such an earplug, with the encapsulated detectable insert, ensures that the earplug, if lost, does not become intermixed with a product and thereby cause contamination. At the same time, by completely encapsulating the insert, the insert does not take up any of the exterior surface area of the earplug, thereby making the plug perform functionally and aesthetically as well as conventional earplugs with the added detection ability. (See the specification at page 4, lines 18-22).

(5) ISSUES

- (1) Claims 1-13 and 16-23 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 4,253,452 to Powers et al. (hereinafter "Powers") in view of U.S. Patent No. 4,936,411 to Leonard (hereinafter "Leonard").

(6) GROUPING OF CLAIMS

The previously stated grouping of claims is maintained.

(7) RESPONSE TO ARGUMENTS

(a) Regarding the rejection of claims 1-13 and 16-23 under 35 U.S.C. 103(a) over Powers in view of Leonard

The Applicant has reviewed the Examiner's comments, but cannot agree.

As stated previously by the Applicant, Powers does not teach or suggest detectable earplugs. Rather Powers teaches a method of securing end portions of earplug cords within a portion of a foamed earplug.

The Examiner indicated on page 4, lines 8-9 of the Examiner's Reply Brief that, with regard to the earplugs of Powers, "the material around the hole 26 is permitted to close...to surround the detectable insert." This is not taught or suggested by Powers. *Nowhere* does Powers teach or suggest installation of a detectable insert, *completely encapsulated or otherwise*.

By contrast, Leonard does teach the installation of a detectable insert. However, Leonard teaches an installation of the detectable insert into a distinctly different kind of earplug having a distinctly defined arrangement. Nowhere does Leonard teach or suggest complete encapsulation (as the Examiner suggests per page 4, lines 4-5 of the Examiner's Reply Brief) of a detectable insert within a foam body. Rather, Leonard specifically relates to molded earplugs and specifically requires that the detectable insert be lodged within a specially contoured channel of the molded earplug. The statement that the earplugs of Leonard may be used with or without a cord is irrelevant to the Applicant's claimed invention, except in so much as it further distinguishes the relative teachings of Leonard and Powers.

The Examiner has relied upon *In re Keller* as a standard for determining whether combination of references is proper. The Applicant *agrees* that a proper test for determining whether such a proposed combination is proper should determine what the proposed combination of references teaches, but the Applicant *strongly cautions* that such a determination should be done without "employing hindsight by using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art." (See *e.g.*, a Federal Circuit discussion in *In re Pieter Kramer*, 18 U.S.P.Q. 2d 1415, citing *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988), for indication of the proper application of *In re Keller*).

As stated previously by the Applicant is that, what is lacking in the prior art is a teaching, without reference to *or even knowledge of* the Applicant's disclosure, that would lead one skilled in the art to use the two described patent references together. Leonard is specifically directed to detectable molded earplugs with a fixed and specially contoured stem channel. Powers is directed to a process for securing an end portion of a cord partially within a foam earplug. Leonard specifically teaches away from foam earplugs by explicitly requiring molded earplugs. Powers does not even relate to earplug detection. For these reasons and the reasons stated in the Applicant's initially filed Appeal Brief, the claims should be allowable.

With further reference to claim 16 (and notwithstanding the above discussion with regard to Claim 16), the Applicant does not plausibly see how either Powers or Leonard, or Powers and Leonard together, describe projection of a detectible insert into a foam body at a predetermined trajectory and speed and allowing the foam body the encapsulate the insert so that the foam body completely surrounds the detectible insert. The Examiner appears to be indicating that placement of an insert (which at least Leonard does) would be the same as projecting an insert into a foam body at a predetermined trajectory and speed. The Applicants cannot agree. For this additional reason, claim 16 and its dependent claims should also be allowable.

(8) CONCLUSION

The rejections of the claims are in error and should be reversed.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicant's Attorneys.

Respectfully submitted,

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